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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/648,325	08/25/2000	Andrew John Holmes	TS7564 (US)	6381

7590 06/10/2004

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EXAMINER

JOHNSON, JERRY D

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 06/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/648,325	HOLMES ET AL.	
	Examiner	Art Unit	
	Jerry D. Johnson	1764	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 4-6 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-6 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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A request for continued examination under 37 CFR 1.114 was filed in this application after a decision by the Board of Patent Appeals and Interferences, but before the filing of a Notice of Appeal to the Court of Appeals for the Federal Circuit or the commencement of a civil action. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on May 28, 2004 has been entered.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matthews et al in view of European Patent Application 0 434 464 A1 and Karn.

Matthews et al., U.S. Patent 4,462,918, teach lubricating oil compositions, and in particular a lubricating oil composition which may be used as a hydraulic fluid (column 1, lines 5-7). The composition comprises a major proportion of a lubricating oil and a minor proportion of each of a Group II metal dithiophosphate and a compound of applicants' formula I (column 1, lines 30-48). The combination of the Group II metal dithiophosphate anti-wear additive with compounds of formula I gives improved anti-wear performance (column 1, lines 49-60). Most preferably, the Group II metal dithiophosphate is a zinc dialkyl dithiophosphate of which the alkyl groups contain 3-20 carbon atoms (column 2, lines 7-14). The combination of additives may suitably be used with other additives (column 2, lines 38-42). While Matthews et al. teach

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the addition of other additives, Matthews et al. differ from the instant claims in not teaching the addition of a magnesium salicylate.

European Patent Application 0 434 464 A1 (hereafter EPA '464) teach lubricant compositions especially useful as hydraulic fluids containing an amino succinate ester as corrosion inhibitor (abstract). EPA '464 teach that when used in an acidic environment, it can be desirable to incorporate, inter alia, overbased alkylsalicylate (page 3, lines 49-52).

Karn, U.S. Patent 4,627,928, is relied on as teaching overbased magnesium alkylsalicylates as additives for hydraulic fluids (column 17, lines 41-47).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to add the overbased magnesium alkylsalicylate of Karn to the lubricating composition of Matthews et al. as taught by EPA '464 and because Matthews et al. specifically teach that other additives may be incorporated into the composition of their invention.

Claims 1 and 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fujitsu et al. in view of Matthews et al.

Fujitsu et al., U.S. Patent 6,114,288, teach lubricating oil compositions comprising a zinc dialkyldithiophosphate and a metallic detergent chosen from calcium alkylsalicylate and a mixture of calcium alkylsalicylate and magnesium alkylsalicylate (abstract). In Tables 2 and 3 of Fujitsu et al., lubricating compositions comprising magnesium salicylate, zinc dialkyldithiophosphate, defoaming agent and pour point depressant are disclosed. In column 5, lines 13-15, Fujitsu et al. specifically teach the addition of alkenyl succinic acid or ester moieties thereof as rust preventing additives for their lubricating compositions.

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Matthews et al., U.S. Patent 4,462,918, teach lubricating oil compositions comprising a major proportion of a lubricating oil and a minor proportion of each of a Group II metal dithiophosphate and a compound of applicants' formula I (column 1, lines 30-48). The combination of the Group II metal dithiophosphate anti-wear additive with compounds of formula I used as anti-rust agents in lubricating oil compositions gives improved anti-wear performance (column 1, lines 49-60). The combination of additives may suitably be used with other additives (column 2, lines 38-42).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a compound of formula I as taught by Matthews et al. in the lubricating composition of Fujitsu et al. because Fujitsu et al. specifically teach the addition of such compounds. Additionally, one having ordinary skill in the art would have been motivated by the desire to increase the anti-wear performance of the lubricating composition as taught by Matthews et al.

Applicant's arguments filed May 28, 2004 have been fully considered but they are not persuasive.

Applicants argue

[t]he Matthews patent deals with the combination of ZnDTP and acidic antirust agent as a means to reduce wear. It makes no mention of the use of salicylates. (Remarks, page 5).

Applicants' argument lacks merit.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on

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combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicants argue “the Waters patent aims at the formulation of ashless (metal-free) hydraulic fluids” and “by contrast Applicants formulation is an ash-containing formulation that contains ash producing compounds such as magnesium salicylate and zinc dithiophosphate” (Remarks, pages 5 and 6). While EPA ‘464 teaches hydraulic fluids which are free from heavy metals, EPA ‘464 does not teach that an overbased alkylsalicylate cannot be used in a hydraulic fluid containing heavy metals. As cited above, EPA ‘464 has been relied on as teaching that when a hydraulic fluid is used in an acidic environment, it can be desirable to incorporate, *inter alia*, an overbased alkylsalicylate (page 3, lines 49-52). Accordingly, it would have been obvious to include an overbased alkylsalicylate in a hydraulic fluid as taught by Matthews et al.; said fluid to be used in an acidic environment.

Applicants argue

[t]he Fujitsu patent deals with lubricating oil for internal combustion engines as stated in the title. According to Dr. Dixon (page 5), a skilled person would understand that it is not relevant to hydraulics and such teachings can not be translated to hydraulic fluids. (Remarks, page 7).

Applicants argument lacks merit.

Column 1, lines 5-7 of Matthews et al. state:

[t]he invention relates to a lubricating oil composition, and in particular to a lubricating oil composition which may be used as a hydraulic fluid.

Clearly the field of relevant prior art is not drawn so narrowly. As the CAFC stated in *In re Deminski*, 796 F.2d 436, 442, 230 USPQ 313, 315 (Fed. Cir. 1986) (quoting *In re Wood*, 599 F.2d 1032, 1036, 202 USPQ 171, 174 (CCPA 1979)): the determination that a reference is from a

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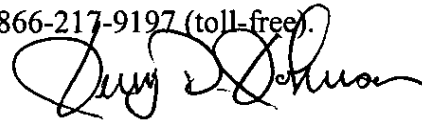
non-analogous art is therefore two-fold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. Following that test, one concerned with the field of hydraulic fluids is clearly chargeable with knowledge of Fujitsu et al. which discloses lubricant compositions comprising functional additives. The reference is "within the field of the inventor's endeavor." Moreover, as long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be combined for the reasons contemplated by the inventor. *In re Kronig*, 539 F.2d 1300, 1304, 190 USPQ 425, 427-428 (CCPA 1976); *In re Lintner*, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). As stated above, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a compound of formula I as taught by Matthews et al. in the lubricating composition of Fujitsu et al. because Fujitsu et al. specifically teach the addition of such compounds. Additionally, one having ordinary skill in the art would have been motivated by the desire to increase the anti-wear performance of the lubricating composition as taught by Matthews et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry D. Johnson whose telephone number is (571) 272-1448. The examiner can normally be reached on 6:00-3:30, M-F, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jerry D. Johnson
Primary Examiner
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